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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,101	04/21/2005	Heon-Sang Ahn	P27779	3930

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EXAMINER

BASICHAS, ALFRED

ART UNIT PAPER NUMBER

3749

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/532,101		AHN, HEON-SANG	
	<b>Examiner</b>		<b>Art Unit</b>	
	Alfred Basichas		3749	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/21/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Al-Bannai (6,001,019), which shows all of the claimed limitations including, among other things,

1. A cake decorating device (see at least col. 1, lines 44-45), comprising: a base 10 having a support pin 12 at a lower surface thereof to be pinned on a cake; a heating unit 30,31 mounted to the base to emit heat (inherent that a candle and sparkler will emit heat); and a displaying unit 18 provided on a vertical wall 16 of the base to show a previously printed message (see at least fig. 2) by heat conduction of the heating unit (see at least Abstract – the heat of the flame or spark causes the pop up of the wall with the message).

2. The cake decorating device as defined in claim 1, wherein the heating unit comprises a support plate 14 mounted to an upper surface of the base; at least one candlestick 30 provided on the support plate; and a candle 30 placed on the candlesticks.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim (5,846,070), which shows all of the claimed limitations including, among other things,

1. A cake decorating device, comprising: a base 10 having a support pin 2 at a lower surface thereof to be pinned on a cake; a heating unit 31 mounted to the base to emit heat (inherent that a candle will emit heat); and a displaying unit 20 provided on a vertical wall 10 of the base to show a previously printed message 11 (see at least fig. 1) by heat conduction of the heating unit 50.

2. The cake decorating device as defined in claim 1, wherein the heating unit comprises a support plate 20 mounted to an upper surface of the base; at least one candlestick 50 provided on the support plate; and a candle 30 placed on the candlesticks.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (5,846,070), which discloses substantially all of the claimed limitations, but does not specifically recite:

3. The cake decorating device as defined in claim 1, wherein the heating unit comprises a base having a rail groove thereon; at least one candlesticks having a locking part at a lower surface thereof to be fitted into the rail groove of the base; and a candle placed on the candlesticks.

4. The cake decorating device as defined in claim 1, wherein the heating unit comprises a base having a plurality of locking holes thereon; at least one candlestick having a locking pin at a lower surface thereof to be fitted into each of the locking holes of the base; and a candle placed on the candlestick.

Official Notice is given that claimed attachment arrangements are old and well known in the art. Such an arrangement has the clear and obvious benefit of providing for efficient attachment of various components. Accordingly, it would have been obvious to one of

ordinary skill in the art at the time of the invention to incorporate the claimed attachments into the invention disclosed by Kim, so as to provide for efficient attachment member.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (5,846,070), which discloses substantially all of the claimed limitations, but does not specifically recite:

5. The cake decorating device as defined in claim 1, wherein the heating unit comprises a plurality of candlesticks each provided with a candle, and adhered onto an upper surface of the base.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a plurality of candles into the invention disclosed by Kim, since it has been held that to provide duplicate parts for multiplied effect is not the type of innovation for which a patent is granted. *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (5,846,070), which discloses substantially all of the claimed limitations, but does not specifically recite:

7. The cake decorating device as defined in claim 1, wherein the heating unit comprises a candle-receiving chamber provided on an upper surface of the base; and a candle having a plurality of candlewicks and received in the candle-receiving chamber.

the claimed chamber is an obvious modification based on design choice, and depends on spatial considerations. In view of the absence of criticality for this particular design, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate it into the invention disclosed by Kim, so as to provide for spatial considerations.

Art Unit: 3749

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (5,846,070), which discloses substantially all of the claimed limitations, but does not specifically recite:

6. The cake decorating device as defined in claim 1, wherein the heating unit comprises a candle-receiving chamber integrated with the base; and a candle having a plurality of candlewicks and received in the candle-receiving chamber.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated integral components in the invention disclosed by Kim, since it has been held that where constituent parts are combined so as to constitute a unitary whole, the unitary whole is deemed integral. *In re Larson*, 144 USPQ 347.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (5,846,070), which discloses substantially all of the claimed limitations, but does not specifically recite:

8. The cake decorating device as defined in claim 1, wherein the displaying unit comprises a transfer paper printed by a thermosensitive microcapsule product.

While the reference may be silent as to how the apparatus is manufactured, the prior art apparatus appears to be the same as claimed. This product-by-process limitation would not be expected to impart distinctive structural characteristics to the apparatus.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized any process including that which is recited in the claims to have produced the print.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Basichas whose telephone number is 571 272 4871. The examiner can normally be reached on Monday through Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571 272 4828. The fax phone numbers for the organization where this application or proceeding is assigned are 571 273 8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center telephone number is 571 272 3700.

August 17, 2006

  
Alfred Basichas  
Primary Examiner